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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		246152014600	
		Application Number 09/869,067	Filed December 17, 1999 (Int'l.)
		First Named Inventor Peter Jan Leonard Mario QUAEDFLIEG et al.	
		Art Unit 1652	Examiner Christian L. Fronda
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>29,959</u></p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. _____</p> <p><u>Kate H. Murashige</u> Signature</p> <p><u>Kate H. Murashige</u> Typed or printed name</p> <p><u>(858) 720-5112</u> Telephone number</p> <p><u>March 13, 2006</u> Date</p>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input checked="" type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			



I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 761643379 US, in an envelope addressed to: MS AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Dated: March 13, 2006

Signature:

Judy Bridgwater
(Judy Bridgwater)

Docket No.: 246152014600
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Peter Jan Leonard Mario QUAEDFLIEG et al.

Application No.: 09/869,067

Filed: December 17, 1999 (Int'l.)

For: PROCESS FOR THE PREPARATION OF
ALPHA-AMINONITRILES WITH
ENHANCED OPTICAL PURITY

Confirmation No.: 1020

Art Unit: 1652

Examiner: Christian L. Fronda

REASONS REVIEW IS REQUESTED

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The invention is directed to a process using enzymes already known in the art to prepare compounds with enhanced optical purity using substrates previously unknown to be acted upon by these known enzymes.

The two substantive outstanding rejections of the pending claims are clearly incorrect. Although a response to final was filed two months ago, no Advisory Action has yet been received, so it is unclear whether the amendment, directed to formal matters has or has not been entered. The amendment merely cancels claim 3 and corrects an obvious error in the dependency of claim 12.

The most evident error in the substantive rejections is the use of a paper by the inventors themselves which postdates the filing date by three years to support a rejection for obviousness over a primary reference. The primary reference fails to disclose the ability of one of the enzymes

included within the scope of the invention, *E.coli* peptide deformylase, to utilize the substrates required in the claimed method. The claimed method employs N-formyl- α -aminonitriles as substrates. There is no disclosure in the primary reference (Rajagopalan) of treating N-formyl- α -aminonitriles with the peptide deformylase disclosed, so the rejection is not based on inherency, but rather on an "expected" property of the peptide deformylase. The "expectation" is based on Sonke et al., published three years subsequent to the filing date herein.¹

The second clear error on the part of the Examiner is the application of *Regents of the University of California v. Eli Lilly* 43 USPQ2d 1398 (Fed. Cir. 1997), and *Fiers v. Revel*, 984 F.2d 1164, 1171, 25 USPQ2d 1601, 1606 (Fed. Cir. 1993) to claims directed to a process which employs known enzymes. There is no rejection based on scope or enablement, rather the rejection is based on an asserted lack of written description. The very paper cited by the Examiner as the primary reference for the obviousness rejection evidences the fact that these enzymes are well known. The application of *Lilly* and *Fiers* to claims involving known materials is clearly inapposite. Please also see *Capon v. Eshhar v. Dudas (as intervenor)*, 418 F.3d 1349, 76 USPQ 1078 (Fed. Cir. 2005) for the proposition there is no *per se* rule even when new compositions are claimed.

For these reasons, Applicants request reconsideration of the rejection of the pending claims, claims 1 and 4-12.

Dated: March 13, 2006

Respectfully submitted,

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¹ The remaining two documents cited in the rejection for obviousness are directed to features of the dependent claims and not relevant to the argument with respect to the sole independent claim, claim 1.